UNITED STATES PATENT AND TRADEMARK OFFICE

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The time period for reply, if any, is set in the attached communication.

1   STATEMENT OF THE CASE[1]

2   Steven Rizzi and Christian Bridgers (Appellants) seek review under

3   35 U.S.C. § 134 (2002) of a non-final rejection of claims 1-4, 8-9, and 11-

4   40, the only claims pending in the application on appeal. We have

5   jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

6   The Appellants invented a way of providing advertising that is

7   tailored to the user without creating a profile of the user. This provides

8   context sensitive promotion based on text contained in an Internet browser

9   designed to maximize the amount of application intelligence on the client

10   end, such that privacy issues and concerns may be mitigated (Spec. ¶ 0001).

11   An understanding of the invention can be derived from a reading of

12   exemplary claim1, which is reproduced below (bracketed matter and some

13   paragraphing added).

14   1. A system for providing Internet advertising, comprising:
15   [1] an advertising server comprising
16   a web server having at least one applet,
17   [2] said advertising server further comprising
18   a database
19   and
20   a servlet
21   for sending said at least one applet to a web
22   browser on another computer
23   and
24   receiving textual content read from said web
25   browser by said at least one applet,
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[1] Our decision will make reference to the Appellants' Appeal Brief ("App.
Br.," filed October 31, 2008) and Reply Brief ("Reply Br.," filed December
29, 2009), and the Examiner's Answer ("Ans.," mailed November 9, 2009).

1   [3] said advertising server comparing
2   said textual content
3   to
4   keyword data stored in said database
5   to determine whether to display an ad on said web
6   browser,
7   [4] wherein no user profiling data is forwarded to the
8   advertising server.

9

10   The Examiner relies upon the following prior art:

       Graham   US 6,804,659 B1   Oct. 12, 2004

11

12   Claims 1-4, 8-9, and 11-40 stand rejected under 35 U.S.C. § 102(e) as

13 anticipated by Graham.[2]

14

15   ISSUES

16   The issues of anticipation turn primarily on whether Graham shows

17 embodiments in which no user profiling data is forwarded to an advertising

18 server.

19

20   FACTS PERTINENT TO THE ISSUES

21   The following enumerated Findings of Fact (FF) are believed to be

22 supported by a preponderance of the evidence.

23   *Facts Related to the Prior Art - Graham*

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[2] The Examiner withdrew the rejections of claims 1-40 under § 102 as anticipated by a PR Newswire article at Answer 6. The Examiner also did not carry the rejections of claim 6 under 35 U.S.C. § 112, second paragraph as indefinite, and of claims 5-7 and 10 under § 102 as anticipated by Graham into the Answer. Thus these rejections are also considered as being withdrawn.

1   01. Graham is directed to internet target marketing for distributing

2   online advertising to viewers based upon the viewers' interests.

3   Graham 1:51-54.

4   02. Graham can target advertising to a user based upon content of an

5   active document, such as one that is presently displayed to a user,

6   or one that is being processed by a daemon or background

7   process. Graham analyzes at least one document to identify

8   discussion of information corresponding to one or more user

9   selectable concepts of interest. This analysis can provide user

10   concept relevance, a measure of relevance of the document to one

11   or more concepts defined by the user, and identify discussion of

12   information corresponding to one or more advertiser selectable

13   concepts of interest. Graham 1:66-2:13.

14   03. Graham uses a content recognizer to analyze a document the user

15   is reading to find words that may be used to in turn find relevant

16   ads. A user's profile can also be used to highlight certain words in

17   a document a user is reading. Those highlighted words, in turn,

18   can be compared to advertising concepts to determine an

19   appropriate ad. Graham describes embodiments using and not

20   using the highlighting from a user profile. Graham 5:40-6:47.

21   04. User profiles are not sent to the server sending the advertisements

22   and are not shared with advertisers. Graham 8:16-27.

23   05. Graham can also rely exclusively on content analysis without

24   resorting to user profiles. Graham 8:29-33.

1 06. Graham shows that the advertisements themselves, apart from the

2 analysis, comes from an advertising server separate from the

3 user's browser. Graham Fig. 1A.

4 07. Graham describes how if the relevance computed for a given

5 document is below a threshold, no advertisement is displayed.

6 Graham 10:40-44.

7

8 ANALYSIS

9 *Claims 1-4, 8-9, and 11-40 rejected under 35 U.S.C. § 102(e) as anticipated*

10 *by Graham.*

11 We are unpersuaded by the Appellants' argument that Graham fails to

12 describe no user profiling data being forwarded to the advertising server.

13 Graham uses several embodiments, some using user profiles and some not.

14 Those that do not, relying exclusively on content analysis of what a user is

15 reading, inherently refrain from forwarding user profiling data, as there is

16 none used to forward. But Graham also describes embodiments where any

17 user profiling data that might be used is retained on the user's computer,

18 since the analysis may be done on the user's computer. FF 01-05. Since the

19 advertisements come from an external server, the advertising server is not on

20 the user's computer. FF 06. We find it unnecessary to unravel the claim

21 construction issue the Appellants pose regarding whether the advertising

22 server is necessarily separate in the claim, since Graham shows such a

23 separate server and the claim clearly admits to such an embodiment.

24 As to claim 23, displaying no ad when there is no match, contrary to

25 the Appellants' contention at Appeal Brief 5, Graham displays no ad under

26 such circumstances. FF 07.

As to claims 34-36, wherein no data is collected to profile a user, contrary to the Appellants' contention at Appeal Brief 5, Graham describes this as one embodiment, relying only on content analysis. FF 03 and 05.

As to claim 38, the Appellants' argument relies essentially on the arguments in support of claim 1.

CONCLUSIONS OF LAW

The rejection of claims 1-4, 8-9, and 11-40 under 35 U.S.C. § 102(e) as anticipated by Graham is proper.

DECISION

The rejection of claims 1-4, 8-9, and 11-40 under 35 U.S.C. § 102(e) as anticipated by Graham is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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